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Exam. DANG, Khanh, GAU: 2111  
Fax No.: (571) 273-8300  
From: George M. Macdonald  
Date: March 15, 2007  
Subject: Serial No.: 09/801,725  
Pages: 36 (including this cover)

Senior Corporate Counsel  
Intellectual Property & Technology Law  
35 Waterview Drive  
P.O. Box 3000  
Shelton, CT 06484-8000  
203-924-3180  
203-924-3919 Fax  
George.Macdonald@pb.com  
www.pitneybowes.com

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Re: U.S. Patent Application Serial No.: 09/801,725  
Confirmation No.: 5084  
Our Docket # F-906-O1

In response to the February 16, 2007 Notice of Non-compliant appeal Brief in the above referenced case, enclosed please find the Appellants' Amended Brief.

### CERTIFICATION OF FACSIMILE TRANSMISSION

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1. Appellants' Amended Brief on Appeal (35 pages).

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A handwritten signature in black ink, appearing to read 'George M. Macdonald'.

George M. Macdonald  
Name of Registered Rep.  
Reg. No.: 39,284

March 15, 2007  
Date

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 Attorney Docket No.: F-906-O1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
 BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:

) Attorney Docket No.: F-906-O1

Tim King, et al.

)

Serial No.: 09/801,725

) Customer No. 919

Filed: March 9, 2001

) Examiner: DANG, Khanh

Confirmation No.: 5084

) Group Art Unit: 2111

) Date: March 15, 2007

Title: SYSTEM AND METHOD FOR SENDING ELECTRONIC MAIL AND  
 PARCEL DELIVERY NOTIFICATION USING RECIPIENT'S  
 IDENTIFICATION INFORMATION

Mail Stop Appeal Brief- Patents  
 Commissioner for Patents  
 PO BOX 1450  
 Alexandria, Virginia 22313-1450

**APPELLANTS' AMENDED BRIEF ON APPEAL**

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 1-17 of the above-identified application mailed November 5, 2004. This Amended Brief on Appeal is submitted in response to the February 15, 2007 Notice of Defective Appeal Brief. The Notice of Appeal was filed in this case on March 7, 2005. Appellants' original Brief was filed June 7, 2005 and an Examiner's Answer was mailed July 25, 2005. Appellants' Reply Brief was filed September 23, 2005 and a paper styled Supplemental Examiner's Answer was mailed November 3, 2005. Accordingly, this brief is timely filed. No fee is believed due. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. **16-1885**.

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on March 15, 2007 (Date of Transmission).  
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 (Signature)

March 15, 2007 (Date)

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

## TABLE OF CONTENTS

- I Real Party in Interest
- II Related Appeals and Interferences
- III Status of Claims
- IV Status of Amendments
- V Summary of Claimed Subject Matter
- VI Grounds of Rejection to Be Reviewed on Appeal
- VII Argument
- VIII Claims Appendix
- IX Evidence Appendix
- X Related Proceedings Appendix

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

### I. Real Party in Interest

The real party in interest in this appeal is Group 1 Software, Inc., a Delaware corporation, the assignee of this application, and a wholly owned affiliate of Pitney Bowes Inc., a Delaware corporation.

### II. Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

### III. Status of Claims

Claims 1, 4, 8, 10-11 [1-4, 17, sic] are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly the subject matter which applicant regards as the invention.

Claims 1-5, 11, 13, 14, 16 and 17 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") apparently in view of alleged subject matter taken by Official Notice that has been disputed.

Claims 6-7 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of U.S. Patent No. 6,343,327 B2 to Daniels, Jr., et al. ("Daniels '327").

Claims 8-9 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of U.S. Patent No. 6,343,327 B2 to Daniels,

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

Jr., et al. ("Daniels '327") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Claim 12 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of alleged subject matter taken by Official.

Claim 15 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of alleged subject matter taken by Official Notice.

Claims 5 and 13 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,944,787 to Zoken ("Zoken '787") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Claim 10 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 6,015,167 to Savino, et al. ("Savino '167") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Appellants hereby appeal the rejection of claims 1-17.

#### IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of November 5, 2004. An Amendment dated January 8, 2004 amended several claims including claim 7. An Amendment dated August 25, 2004 presented a version of claim 7 entitled "Previously Amended" that apparently corrected a typographical omission of the word "classes." Appellants did not receive a notice indicating that the August 25, 2004 Amendment was not compliant or would not be entered and have thus included claim 7 as presented then in the Appendix. The Examiner has objected in the Final Office Action to the lack of the term "classes" in claim 7, but it is Appellants' understanding that the term is present. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

V. Summary of Claimed Subject Matter

Appellants' invention as presently claimed relates to methods and systems for sending electronic mail using recipient's identification information. Illustrative embodiments describe an e-mail system, an e-mail post office, and a method for forwarding e-mail, by using physical address information of the recipient and mapping that to a constant permanent e-mail address.

The following four independent claims are on appeal. Appellants do not concede that 35 USC section 112, sixth paragraph has been invoked, but identify certain structure as shown below relating to elements including the term means in the currently pending claims. For example, the term "traditional mail delivery means" is used in claims 6 and 8 and described at least in paragraph 29 of the Specification at page 7. Such language does not implicate 35 USC section 112, sixth paragraph.

Following the recitation of the independent claims on appeal, Appellants set forth an illustrative concise description of illustrative embodiments of the application that may be useful in considering the claims on appeal directed to limitations claimed in independent and dependent claims as separately argued. The claims may cover multiple illustrative embodiments and therefore even the illustrative recitations are not exhaustive. Appellants refer to the specification by page and line number as well as references to reproduced Figures 5, 1, 3 and 4 along with the associated textual description and the cited reference numerals. Certain sections of the concise description have been underlined for emphasis. Claims 1, 5 and 8-10 are the independent claims on appeal and are reproduced below.

1. A system for routing e-mails, comprising:

a server that includes a database, said database including a mapping from a physical address to an e-mail address, wherein said server including means for mapping a physical address to an address of an electronic mailbox upon receipt of an e-mail from a party, said server is connected to a network, said server further including an electronic mailbox for each physical address, wherein said electronic mailbox is associated with an account number and password; and

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

a recipient host that includes a web browser, said recipient host connected to said network, wherein said host can access said electronic mailbox on said server using said account number and said password. (emphasis added).

With regard to independent claim 1, an illustrative embodiment teaching a system for routing e-mails is shown in the specification at page 12, paragraph 48 through page 16, paragraph 64 wherein the systems of FIG. 5 and the further detail of FIG. 6 is described. The email server 530 and 600 are described. FIG. 1 shows an illustrative process performed by an email sender. In steps 120 or 130, the physical address is entered. FIG. 2 shows an illustrative process performed by an email recipient. In step 240, the recipient checks the inbox on an email server.

With regard to claim 1, the term means for allowing is utilized, but does not necessarily implicate 35 USC section 112, sixth paragraph since the server recitation provides structure. For example the Server 530 shown in FIG. 5 is an illustrative structure along with the description at Specification paragraphs 48-55. Another Server structure described as an illustrative server 530 is Computer System 600 along with the description at Specification paragraphs 56-62.

With regard to claim 2, the term means for allowing is utilized, but does not necessarily implicate 35 USC section 112, sixth paragraph since the server recitation provides structure. For example the Server 530 shown in FIG. 5 is an illustrative structure along with the description at Specification paragraphs 48-55. Another Server structure described as an illustrative server 530 is Computer System 600 along with the description at Specification paragraphs 56-62.

5. A method for routing e-mail, comprising the following steps:  
allowing a user to specify a physical address of a recipient to whom  
the e-mail is to be sent; and  
performing a mapping function on a server, said mapping function  
mapping said physical address of said recipient to an e-mail address of  
said recipient. (emphasis added).

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

With regard to independent claim 5, an illustrative embodiment teaching a method for routing e-mail is shown in the specification at page 4, paragraph 15 through page 12, paragraph 47 describing processes from several perspectives. An illustrative system that may be used is shown at specification page 12, paragraph 48 through page 16, paragraph 64 wherein the systems of FIG. 5 and the further detail of FIG. 6 is described. The email server 530 and 600 are described. FIG. 1 shows an illustrative process performed by an email sender. In steps 120 or 130, the physical address is entered. FIG. 3 shows an illustrative process performed by an email server. In step 307, the server maps a physical address to recipient's inbox.

8. A method for routing e-mail, comprising the following steps:
  - sending an e-mail using a physical address of a recipient, wherein said e-mail has a designator tag that associates said e-mail with one or a plurality of classes of service;
  - performing a mapping function on a server upon receipt of said e-mail, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient;
  - specifying said classes for which said recipient desires to receive a physical mailpiece and said classes for which said recipient desires to receive an actual copy of the e-mail in a mail control file;
  - storing the e-mail in an electronic mailbox of said recipient; and
  - if said recipient chooses to receive physical mail, then routing the e-mail to a printer where the e-mail is printed, delivering the e-mail via traditional mail delivery means, and electronically notifying said recipient and sender that a physical copy of the e-mail was sent to said recipient.

With regard to independent claim 8, an illustrative embodiment teaching a method for routing e-mail is shown in the specification at page 4, paragraph 15 through page 12, paragraph 47 describing processes from several perspectives. An illustrative system that may be used is shown at specification page 12, paragraph 48 through page 16, paragraph 64 wherein the systems of FIG. 5 and the further detail of FIG. 6 is described. The email server 530 and 600 are described. FIG. 3 shows an illustrative process performed by an email server. In step 340, the server uses e-designators to decide whether to deliver by traditional distribution means.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

9. A system for routing e-mails, comprising:  
a server that includes a database, said database including a  
mapping from a physical address to an e-mail address, wherein said  
server is connected to a network, said server further including an  
electronic mailbox for each physical address, wherein  
said electronic mailbox is associated with an account number and  
password, wherein said server includes a mail control file containing E-  
designators, said E-designators representing classes of service; and  
a recipient host, said host being able to access e-mails on said  
server using said account number and said password. (emphasis added).

With regard to independent claim 9, an illustrative embodiment teaching a system for routing e-mails is shown in the specification at page 12, paragraph 48 through page 16, paragraph 64 wherein the systems of FIG. 5 and the further detail of FIG. 6 is described. The email server 530 and 600 are described. FIG. 1 shows an illustrative process performed by an email sender. In steps 120 or 130, the physical address is entered. FIG. 2 shows an illustrative process performed by an email recipient. E-designators are described in several locations including Specification paragraph 31. In step 240, the recipient checks the inbox on an email server.

10. A method for parcel delivery notification, comprising the following steps:  
(a) receiving an electronic order for a parcel;  
(b) generating a parcel barcode;  
(c) scanning a parcel barcode;  
(d) sending an e-mail to a buyer who placed said electronic order by e-mail, wherein a physical address of said buyer is used to send said e-mail, said step (d) occurring upon executing said scanning step (c);  
(e) shipping the parcel to a parcel delivery center;  
(f) scanning the parcel barcode at said parcel delivery center; and  
(g) electronically notifying said buyer who placed said electronic order by e-mail, wherein said physical address of said buyer is used to send said e-mail, said step (g) occurring upon executing said step (f). (emphasis added).

With regard to independent claim 10, an illustrative embodiment teaching a method for routing e-mail is shown in the specification at page 4, paragraph 15 through page 12, paragraph 47 describing processes from several perspectives. An illustrative

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

system that may be used is shown at specification page 12, paragraph 48 through page 16, paragraph 64 wherein the systems of FIG. 5 and the further detail of FIG. 6 is described. The email server 530 and 600 are described. FIG. 4 shows an illustrative process for processing parcels. In step 450, the process uses a physical address to create a notification email.

An e-mail system is described in which the transmitting host transmits the e-mail addressed to the recipient's physical address (e.g., home or work address). Therefore, even if the recipient has selected another electronic mail service provider without notifying the sender, the sender only needs to know the name and/or physical address of the recipient.

The sender can elect to use the system to send e-mail that would later be printed at a postal distribution center and distributed to the recipient via traditional delivery means. If the sender makes a typographical error in the recipient's physical address, the e-mail can be corrected by proprietary software and the mail will still arrive at the recipient's physical address. Additionally, the described system facilitates parcel delivery by notifying the recipient of a parcel with delivery status information of the parcel while the parcel is en route to the recipient of the parcel.

Figure 5 is reproduced below to show a representative system and Figures 1, 3-4 are reproduced to illustrate representative processes according to an illustrative embodiments of the application.

Serial No.: 09/801,725  
 Attorney Docket No.: F-906-O1

Patent

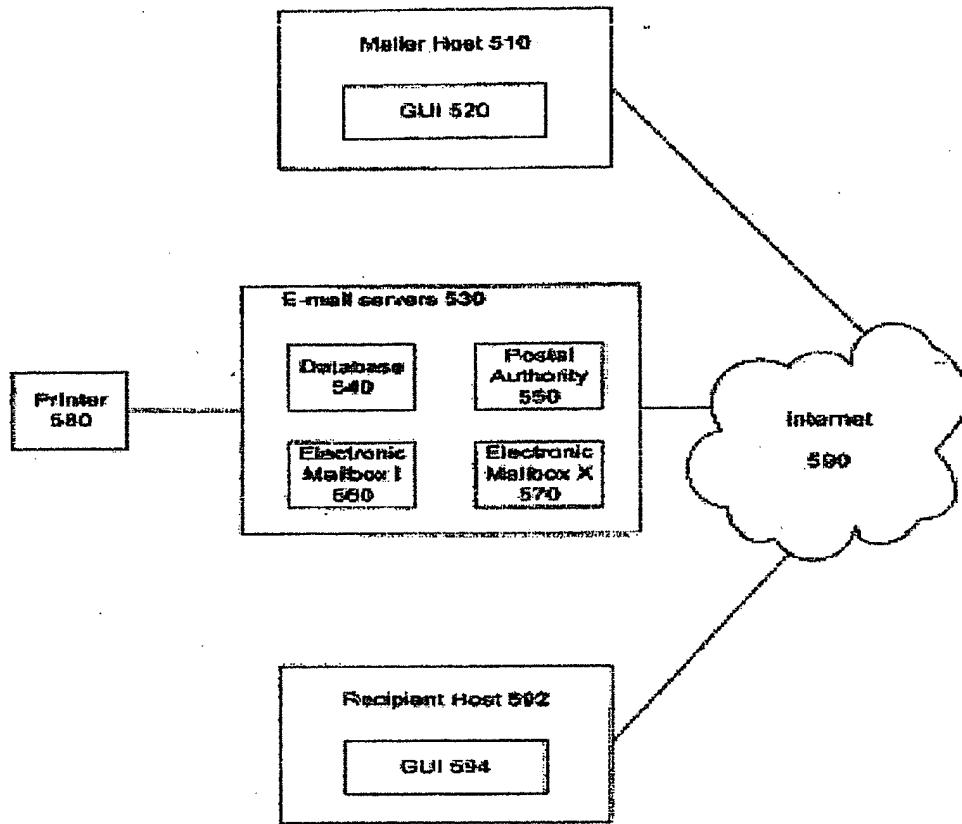


FIG. 5

FIG. 5 is a block diagram illustrating the physical architecture of an illustrative e-mail routing system 500, according to an embodiment of the present invention.

Recipient host 580 and sender host 510 can be directly connected to e-mail server 530, and sender host 510 can be directly connected to e-mail server 530. Mailer host 510 is a host allowing the sender (also referred to as a mailer) to connect to the e-mail server 530. The sender uses Graphical User Interface (GUI) 520 to e-mail the recipient. Upon connecting to e-mail server 530, the sender enters a physical address into the GUI 520 manually, or the sender selects from the list of information provided by proprietary database 540. Once again, a sender's database located on the sender host 510 can also be used. The e-mail routing system 500 includes e-mail server 530. E-mail server

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

530 includes database 540. Database 540 can be any database system known to one skilled in the art such as Oracle or Sybase. E-mail server 530 also contains postal authority 550. Postal authority 550 is an authoritative process running on e-mail server 530 that performs security checking. Electronic mailbox 560 represents the electronic mailbox of one particular recipient, and electronic mailbox 570 represents the electronic mailbox of another recipient. Thus, each recipient has an electronic mailbox where the e-mail for that particular recipient is stored.

Printer 592 can be any printer traditional network printer and is used by e-mail server 530 to print hard copies of e-mail in the situation where the recipient has specified receiving mail in hard copy form (i.e. hybrid mail). The printer can be located local to the e-mail server 530 or at a geographically remote site, such as the recipient's local USPS facility. Recipient host 580 and UI 590 is used by the recipient to connect to e-mail server 530 via Internet 598 to check the recipient's e-mail stored in electronic mailbox 560. In one embodiment a UI 590 can be used by the recipient to specify whether the recipient desires to receive physical mail or e-mail or a combination thereof. See Specification paragraphs 48-55 (emphasis added).

Serial No.: 09/801,725  
 Attorney Docket No.: F-906-O1

Patent

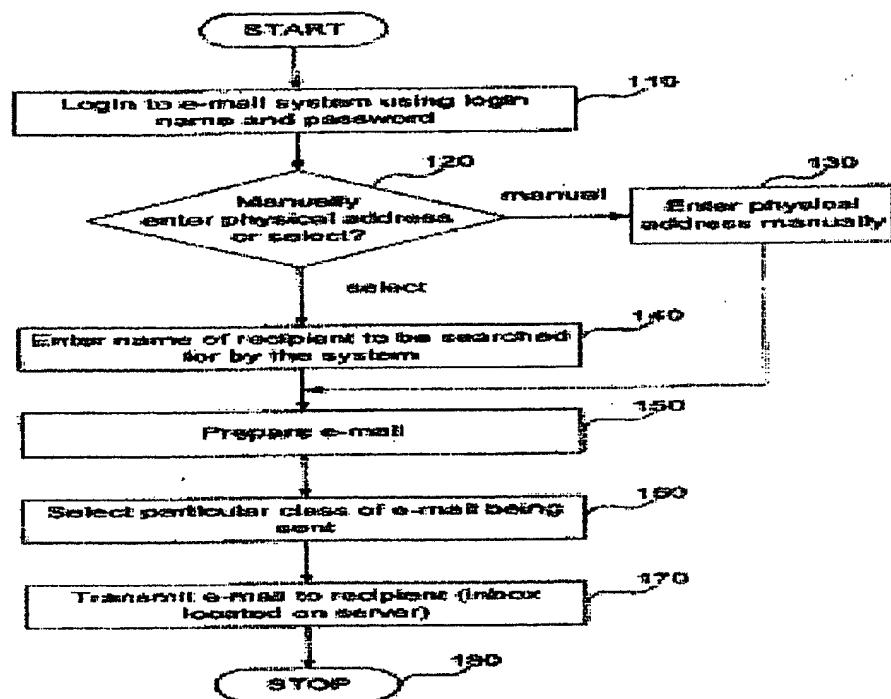


FIG. 1

FIG. 1 describes the operational flow of the steps of sending an e-mail to a recipient as executed by an e-mail sender according to an illustrative embodiment. In step 110, a sender logs in to the e-mail system. In step 120, the sender is provided with the option of manually entering a physical address of the recipient or choosing the physical address of the recipient from a sender's list. If manual entry is selected a GUI is used in step 130. For instance, if the sender knows the physical address of the recipient Santa, the recipient can manually enter the address in the address line of the e-mail software application (e.g. Groupwise@, Microsoft Mail@). In such a situation, the sender enters "123 North Pole Lane, NorthPole, U.S.A." The e-mail server then receives the e-mail and determines that that particular e-mail should be routed to Santa's electronic in-box located on an e-mail server. In one embodiment, the e-mail server is maintained by the United States Postal Service (USPS). Prior to routing the e-mail to the recipient, Coding, Accuracy, Support System (CASS) certified software, can be used to correct typographical errors in the entered address.

Serial No.: 09/801,725  
 Attorney Docket No.: F-906-O1

Patent

In one embodiment, e-mail is divided into classes and prioritized. Such classes may not correspond to the existing classes of mail of the U.S. Postal Service. Each class is represented by an E-designator stamp. Thus, in step 160 the sender selects the particular class of e-mail being sent. For example, if the sender wishes to send important first class e-mail, the sender enters "E-designator-first-class" in a GUI of an e-mail software package being used. The e-mail server contains a mail control file for the particular user indicating that "E-designator-first-class" types of mail should be printed in hard copy form and distributed via traditional distribution means. The mail control file is configurable by the recipient. See Specification paragraphs 15-27 (emphasis added).

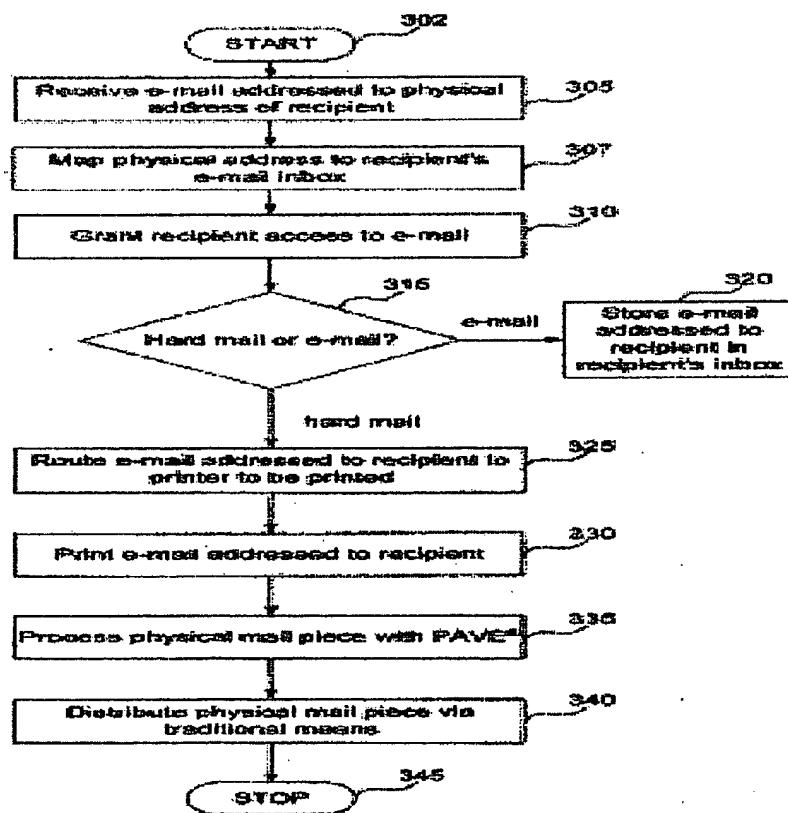


FIG. 3

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

FIG. 3 is a flowchart that describes the operational flow of the steps executed by the e-mail server, upon receiving e-mail addressed to a recipient. In step 305, the e-mail arrives at the e-mail server. The e-mail server maps a physical address to a recipient, as shown in step 307. In one embodiment, this function is performed via a database. The e-mail server includes a database with the name, address, and account information (i.e., recipient's e-mail box). Thus, the server can merely look up a recipient's e-mail inbox (or address) by using the physical address. In step 310, an authoritative process stored on the e-mail server grants the recipient access. In step 315, the system prompts the recipient regarding the desired form of communication to be received. The e-mail server either receives input from the recipient indicating that the recipient wishes to receive hybrid mail or a copy of the actual e-mail that was transmitted by the sender. If a copy is selected, the e-mail server stores e-mail addressed to the recipient in the recipient's inbox on the e-mail server in step 320. If hybrid mail is selected, the e-mail server routes the e-mail for the recipient to a printer, in step 325. In step 330, the physical mailpiece is then printed. In step 335, the physical mailpiece is electronically processed using Presort, Accuracy, Validation, and Evaluation (P A VE) software. This software presorts the mail in accordance with USPS regulations to maximize postage discounts. In step 340, the physical mailpiece is distributed via traditional distribution means. See Specification paragraphs 35-42 (emphasis added).

Serial No.: 09/801,725  
 Attorney Docket No.: F-906-O1

Patent

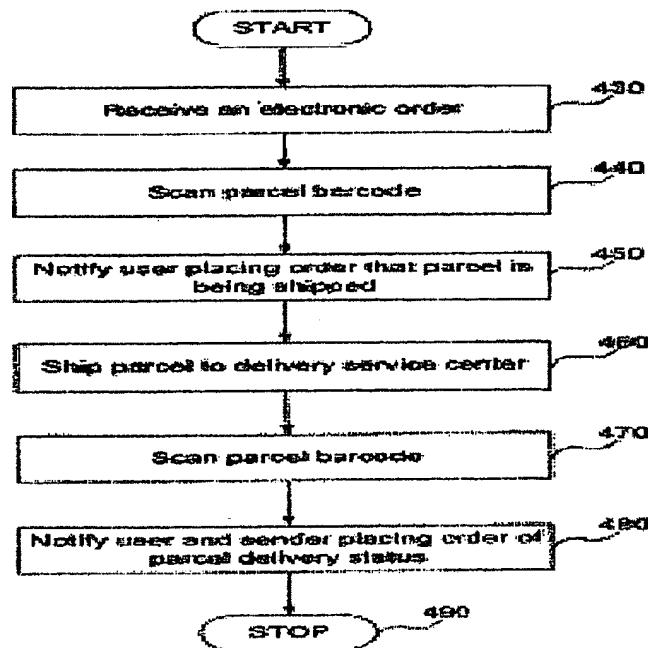


FIG. 4

FIG. 4 is a flowchart that describes the operational flow of the steps in which parcels are processed. For example, a recipient desiring to receive a pair of shoes from a catalog distribution center, logs into the email server using his host. The user desiring to receive the parcel then enters the parcel delivery system of the sender distribution center. After entering the system, the user desiring to receive the parcel places an order for the shoes electronically by answering a series of questions, including being prompted for physical address information. In step 430, the sender of the parcel receives the electronic order, generates electronic postage, and places a barcode label on the parcel. In step 440, the sender scans the barcode label. In step 450, upon scanning the barcode label, the recipient of the parcel is notified via e-mail that his parcel is currently being shipped. Once again, only the physical address and/or name of the recipient (e.g., the buyer) of the package is used to send the e-mail notification. Other information such as a tracking number, expected shipping date, expected delivery date, and delivery service is included in the e-mail sent to the buyer who placed the parcel order. In step 460, the parcel is shipped from the catalog distribution center to a

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

delivery service center. In step 470, upon arrival at the delivery service center, the parcel is scanned again. In step 480, upon scanning, the e-mail server automatically sends another electronic notification message to the recipient that the parcel has arrived. The e-mail server also sends an electronic message to the sender that the parcel was delivered. See Specification paragraphs 43-47 (emphasis added).

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

#### VI. Grounds of rejection to Be Reviewed on Appeal

Whether claims 1, 4, 8, 10-11 are patentable under 35 U.S.C. §112.

Whether claims 1-5, 11, 13, 14, 16 and 17 are patentable under 35 U.S.C. §103(a).

Whether claims 6-7 are patentable under 35 U.S.C. §103(a).

Whether claims 8-9 are patentable under 35 U.S.C. §103(a).

Whether claim 12 is patentable under 35 U.S.C. §103(a).

Whether claim 15 is patentable under 35 U.S.C. §103(a).

Whether claims 5 and 13 are patentable under 35 U.S.C. §103(a).

Whether claim 10 is patentable under 35 U.S.C. §103(a).

#### VII. Argument

As Appellant discusses in detail below, the final rejection of claims 1-17 is unsupported by the cited references. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a *prima facie* case of unpatentability. For this reason alone, Appellant is entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). The Examiner has attempted to shift the

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

burden of proof, but Appellants submit that the Examiner bears the burden of establishing a *prima facie* case of unpatentability and that the Examiner has not put forth such a case.

**A. The Cited References Are Not Properly Combined Under 35 U.S.C. Section 103(a)**

In many instances in the Final Office Action, the Examiner has made troubling extensive statements regarding Official Notice that will be described here and in further detail below. In particular, the Examiner admits that a particular limitation is not met in the art, then takes Official Notice of a different concept, provides no motivation to combine and concludes that a *prima facie* case of obviousness has been established.

The Examiner then spends pages mischaracterizing the Official Notice process. See Final Office Action at pages 9-18 and at page 14. Appellants are not required to prove that something does not exist in the prior art. Appellants have provided detailed reasoned arguments refuting the statements of Official Notice, the motivation to combine them and the sufficiency of them to provide a *prima facie* obviousness rejection. The Examiner cites to *In re Chevenard*, 139 F.2d 711, 60 USPQ 239 (CCPA 1943) regarding general allegations of patentability. In this case, Appellants on at least two prior occasions have provided reasoned arguments refuting the statements of Official Notice. See MPEP 2144.03.

The following example is illustrative of the misapplication of Official Notice in the Final Office Action.

At page 4 of the Final Office Action, the Examiner states:

However, Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art. See Final Office Action at page 4.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

It seems quite clear that the element that the Examiner admits is missing from the prior art is not equivalent to the statement of Official Notice. Even if it were, there is not articulated motivation to combine them.

As the Federal Circuit has held, “[I]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art ...” See *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1998). See also *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F. 3d 877 (Fed. Cir. 1998).

Accordingly, the references are not properly combined for at least the reasons stated above and the rejection should be reversed.

**B. Claims 1, 4, 8, 10-11 are not Unpatentable under 35 U.S.C. § 112**

Claims 1, 4, 8, 10-11 [1-4 and 17, sic] are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 112, second paragraph as allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

Clear black letter law states that the claims are not limited to a particular embodiment described in a specification. *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855 (Fed. Cir. 1988). Here, the invention as presently claimed is completely consistent with the preferred embodiments described and would be understood by one of skill in the art with reference to the specification, particularly the sections emphasized above in the summary. See *Orthokinetics, Inc. v. Safety Travel Charis, Inc.*, 806 F.2d 1565, 1 PQ2d 1081 (Fed. Cir. 1986).

Regarding claims 1, 4 and 11, the Examiner states:

Claims 1,4, and 11 are directed to an apparatus claim. However, the essential structural cooperative relationship between the so-called “means for mapping” and other recited elements in the claims have been omitted, such omission amounting to a gap between the necessary

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

structural connections. See MPEP § 2172.01. See Final Office Action at page 2.

Claim 1 recites:

1. A system for routing e-mails, comprising:  
a server that includes a database, said database including a mapping from a physical address to an e-mail address, wherein said server including means for mapping a physical address to an address of an electronic mailbox upon receipt of an e-mail from a party, said server is connected to a network, said server further including an electronic mailbox for each physical address, wherein said electronic mailbox is associated with an account number and password; and  
a recipient host that includes a web browser, said recipient host connected to said network, wherein said host can access said electronic mailbox on said server using said account number and said password. (emphasis added).

Appellants respectfully disagree with the rejection. The means for mapping is part of the recited server. The recipient host "can access e-mails on said server" per claim 1. Thus, all the elements are connected as required by 35 U.S.C. § 112, second paragraph.

Regarding claims 8 and 10, the Examiner states:

In claim 8, line 4, the phrase, "sending an email using physical address of a recipient" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address.

In claim 10, lines 12-13, the phrase, "the physical address of said buyer is used to send said email" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address. See Final Office Action at page 2.

Claim 8 is illustrative and recites:

8. A method for routing e-mail, comprising the following steps:  
sending an e-mail using a physical address of a recipient, wherein said e-mail has a designator tag that associates said e-mail with one or a plurality of classes of service;

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

performing a mapping function on a server upon receipt of said e-mail, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient;

specifying said classes for which said recipient desires to receive a physical mailpiece and said classes for which said recipient desires to receive an actual copy of the e-mail in a mail control file;

storing the e-mail in an electronic mailbox of said recipient; and

if said recipient chooses to receive physical mail, then routing the e-mail to a printer where the e-mail is printed, delivering the e-mail via traditional mail delivery means, and electronically notifying said recipient and sender that a physical copy of the e-mail was sent to said recipient. (emphasis added).

Appellants respectfully disagree with the rejection. With regard to FIG. 1 as described above: In step 120, the sender is provided with the option of manually entering a physical address of the recipient or choosing the physical address of the recipient from a sender's list. If manual entry is selected a GUI is used in step 130. For instance, if the sender knows the physical address of the recipient Santa, the recipient can manually enter the address in the address line of the e-mail software application (e.g. Groupwise@, Microsoft Mail@). In such a situation, the sender enters "123 North Pole Lane, NorthPole, U.S.A." The e-mail server then receives the e-mail and determines that that particular e-mail should be routed to Santa's electronic in-box located on an e-mail server.

The Examiner is attempting to narrow the scope of Applicants' invention inappropriately based on his comments by reading limitations from the specification into the claims. This is inappropriate. See MPEP § 2173.04 ("Breadth of a claim is not to be equated with indefiniteness.") Applicants' invention is sending a e-mail using the physical address of the recipient. This is clearly recited in the claim. Also, the claim recites multiple steps, which have been ignored by the Examiner.

Thus, the invention as presently claimed in claims 8 and 10 would be understood by one of ordinary skill in the art to teach sending an email using a physical address and complies with 35 U.S.C. § 112, second paragraph.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

C. Claims 1-5, 11, 13, 14, 16-17 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 1-5, 11, 13, 14, 16 and 17 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") apparently in view of alleged subject matter taken by Official Notice that has been disputed.

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, *supra*; *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

In the Final Office Action, the Examiner rejected claims 1-5, 11, 13, 14, 16 and 17 under 35 U.S.C. section 103(a). Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

Claim 1 is directed to a system for routing e-mails and is shown below:

1. A system for routing e-mails, comprising:  
a server that includes a database, said database including a mapping from a physical address to an e-mail address, wherein said server including means for mapping a physical address to an address of an electronic mailbox upon receipt of an e-mail from a party, said server is connected to a network, said server further including an electronic mailbox

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

for each physical address, wherein said electronic mailbox is associated with an account number and password; and

a recipient host that includes a web browser, said recipient host connected to said network, wherein said host can access said electronic mailbox on said server using said account number and said password. (emphasis added).

Appellants respectfully urge reversal for at least the following reasons. At page 4 of the Final Office Action, the Examiner states:

However, Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of searching a recipient's email address using a recipient's physical address, since the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a data base is old and well-known; and providing Hogan with such a search capability only involves ordinary skill in the art. See Final Office Action at page 4.

It seems quite clear that the element that the Examiner admits is missing from the prior art is not equivalent to the statement of Official Notice. Even if it were, there is not articulated motivation to combine them.

Furthermore, Hogan describes a technique for delivery of bills over a communication network, and payment of bills through the network using a personal computer. Hogan, col. 3, lines 47-50. A subscriber's personal data, including address and e-mail, are stored. Col. 5, lines 22-36. Subscriber's can access a bill via the Internet, and pay the bill using one or more accounts. Col. 5, lines 1-5. The customer can view full graphics of the bills, print the bills, and download the bill for storage. Col. 5, lines 6-9. The invention as presently claimed is directed to allowing a party to send an electronic mail message (e-mail) using the physical address of a recipient instead of his/her e-mail address (which may be unknown). This is clearly not disclosed in Hogan. Hogan only describes associating a physical address and an e-mail with a subscriber. Hogan does not describe "a mapping from a physical address to an e-mail address" as recited in independent claim 1. It is therefore further argued that Hogan does not disclose mapping from a physical address to an e-mail address upon receipt of an e-mail from a party. The stated Official Notice does not cure the defect in the rejection.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

Nevertheless, the Examiner opines that it would be obvious to one of ordinary skill in the art to provide Hogan with an option of searching a recipient's e-mail address using a recipient's physical address. This assumes that the server in Hogan receives e-mail addressed using a physical address, which it does not. Accordingly, Hogan does not provide any suggestion for performing this step. Further, the Examiner has provided absolutely no motivation for Hogan to perform such a search within a billing system. The Examiner is clearly using impermissible hindsight to reject the claims.

The Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a database is old and well known. The fact that searching a database is well known does not make it obvious to map a physical address to an e-mail address (for sending an e-mail message). The Examiner is merely combining disparate portions of the art to reject the claimed invention.

Appellants have respectfully requested that the Examiner provide a suggestion within the four corners of Hogan to use a physical address of a recipient to send an e-mail. The Examiner takes Official Notice on multiple occasions throughout the Final Office Action. Appellants have provided reasoned reasons refuting such notice and challenging the motivation to combine any such notice and its sufficiency in completing a *prima facie* obviousness rejection.

Further, the Examiner has often jumped to the conclusion that combining two well known elements or process steps is obvious without any suggestion or motivation within the prior art. This is impermissible. Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143,227 USPQ 543, 551 (Fed. Cir. 1985). The Examiner has failed to show that one of ordinary skill in the art would have been motivated by the combined teachings of the cited references in a manner which would have resulted in the claimed invention.

Regarding claim 5, the cited references do not teach or fairly suggest at least the mapping function:

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

5. A method for routing e-mail, comprising the following steps:  
allowing a user to specify a physical address of a recipient to whom  
the e-mail is to be sent; and  
performing a mapping function on a server, said mapping function  
mapping said physical address of said recipient to an e-mail address of  
said recipient. (emphasis added).

Regarding claims 2,3, 4 and 17, the Examiner has not articulated a rejection for those claims and the rejection should be reversed on that basis alone.

2. The system of claim 1, wherein  
said server provides means for allowing said recipient to request  
that said e-mail be printed and forwarded via traditional mail.

3. The system of claim 1, wherein  
said server provides a graphical user interface that allows a  
recipient to select whether electronic mail is delivered to said electronic  
mailbox or is delivered via traditional mail.

4. The system of claim 1, further comprising  
a mailer host that includes a web browser, said mailer host  
connected to said network, wherein said mailer host includes a graphical  
user interface that allows said recipient to forward an e-mail to said  
recipient using said physical address.

17. The method of claim 5, further comprising  
allowing said user to associate the e-mail with a class of service  
selected from a plurality of classes. (emphasis added).

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claims 1-5, 11, 13, 14, 16 and 17 is in error and should be reversed.

D. Claims 6-7 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 6-7 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of U.S. Patent No. 6,343,327 B2 to Daniels, Jr., et al. ("Daniels '327").

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

Appellants respectfully disagree with the rejection for at least the reasons described above. Furthermore, claim 6 recites:

6. The method of claim 5, further comprising the step of allowing said recipient to choose between receiving a physical mailpiece and an e-mail, wherein if said recipient chooses to receive e-mail, then storing the e-mail in an electronic mailbox for said recipient; and wherein if said recipient chooses to receive physical mail, then routing the e-mail to a printer where the e-mail is printed and delivered via traditional mail delivery means. (emphasis added).

Hogan does not disclose "allowing a user to specify a physical address of a recipient to whom [an] e-mail is to be sent" nor does Hogan disclose "performing a mapping function on a server, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient." Further, dependent claim 6 recites "routing an e-mail to a printer where the e-mail is printed and delivered via traditional mail delivery means." Hogan does not disclose printing an e-mail and delivering it via traditional mail. Still further, amended dependent claim 7 states that the e-mail is associated with one of a plurality of classes. This is also not taught by Hogan.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claims 6-7 is in error and should be reversed.

**E. Claims 6-7 are not Unpatentable under 35 U.S.C. § 103(a)**

Claims 8-9 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of U.S. Patent No. 6,343,327 B2 to Daniels, Jr., et al. ("Daniels '327") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 1. Furthermore, independent claims 8 and 9 recite:

8. A method for routing e-mail, comprising the following steps:

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

sending an e-mail using a physical address of a recipient, wherein said e-mail has a designator tag that associates said e-mail with one or a plurality of classes of service;

performing a mapping function on a server upon receipt of said e-mail, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient;

specifying said classes for which said recipient desires to receive a physical mailpiece and said classes for which said recipient desires to receive an actual copy of the e-mail in a mail control file;

storing the e-mail in an electronic mailbox of said recipient; and

if said recipient chooses to receive physical mail, then routing the e-mail to a printer where the e-mail is printed, delivering the e-mail via traditional mail delivery means, and electronically notifying said recipient and sender that a physical copy of the e-mail was sent to said recipient.

9. A system for routing e-mails, comprising:

a server that includes a database, said database including a mapping from a physical address to an e-mail address, wherein said server is connected to a network, said server further including an electronic mailbox for each physical address, wherein

said electronic mailbox is associated with an account number and password, wherein said server includes a mail control file containing E-designators, said E-designators representing classes of service; and

a recipient host, said host being able to access e-mails on said server using said account number and said password. (emphasis added).

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claims 8-9 is in error and should be reversed.

F. Claim 12 is not Unpatentable under 35 U.S.C. § 103(a)

Claim 12 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of alleged subject matter taken by Official Notice.

Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 1.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claim 12 is in error and should be reversed.

**G. Claim 15 is not Unpatentable under 35 U.S.C. § 103(a)**

Claim 15 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,699,528 to Hogan ("Hogan '528") in view of alleged subject matter taken by Official Notice.

Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 5.

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claim 15 is in error and should be reversed.

**H. Claims 5 and 13 are not Unpatentable under 35 U.S.C. § 103(a)**

Claims 5 and 13 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 5,944,787 to Zoken ("Zoken '787") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Here, the Examiner admits that the elements directed to mapping the physical address of a recipient to an email address of a recipient are not disclosed. The rejection should be reversed for that reason alone.

Regarding claim 5, the cited references do not teach or fairly suggest at least the mapping function:

5. A method for routing e-mail, comprising the following steps:  
allowing a user to specify a physical address of a recipient to whom the e-mail is to be sent; and  
performing a mapping function on a server, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient. (emphasis added).

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

Zoken, like Hogan, fails to teach or suggest mapping a physical address of a recipient to an e-mail address as admitted by the Examiner. There is simply no motivation within Zoken to make such a modification to the system of Zoken. The Examiner is merely using impermissible hindsight.

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claims 5 and 13 is in error and should be reversed.

I. Claim 10 is not Unpatentable under 35 U.S.C. § 103(a)

Claim 10 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent No. 6,015,167 to Savino, et al. ("Savino '167") apparently in further view of alleged subject matter taken by Official Notice that has been disputed.

Independent Claim 10 recites:

10. A method for parcel delivery notification, comprising the following steps:
  - (a) receiving an electronic order for a parcel;
  - (b) generating a parcel barcode;
  - (c) scanning a parcel barcode;
  - (d) sending an e-mail to a buyer who placed said electronic order by e-mail, wherein a physical address of said buyer is used to send said e-mail, said step (d) occurring upon executing said scanning step (c);
  - (e) shipping the parcel to a parcel delivery center;
  - (f) scanning the parcel barcode at said parcel delivery center; and
  - (g) electronically notifying said buyer who placed said electronic order by e-mail, wherein said physical address of said buyer is used to send said e-mail, said step (g) occurring upon executing said step (f).  
(emphasis added).

As discussed above with at least reference to claim 1, the invention as claimed allows a physical address of a recipient to be used to send an e-mail. Independent claim 10 clearly recites this feature. The Savino patent fails to teach or suggest at least this feature. Furthermore, the Examiner alleges that is was well known to send an e-mail

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

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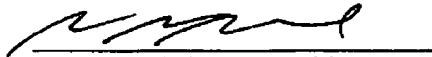
notification to a buyer after an on-line purchase, but not that an e-mail be sent to a purchaser using his/her physical address as recited in claim 10. In order to establish a *prima facie* rejection, it is not enough for the Examiner to merely take Official Notice and then with hindsight opine that the claim is obvious.

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection. For at least these reasons, Appellants respectfully submit that the final rejection as to claim 10 is in error and should be reversed.

**IX. Conclusion**

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-17 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



George M. Macdonald  
Reg. No. 39,284  
Attorney for the Appellants  
Telephone (203) 924-3180

**PITNEY BOWES INC.**  
Intellectual Property and Technology Law Department  
35 Waterview Drive, P.O. Box 3000  
Shelton, CT 06484-8000

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

**VIII – CLAIMS APPENDIX**  
**APPENDIX A**

1. A system for routing e-mails, comprising:
  - a server that includes a database, said database including a mapping from a physical address to an e-mail address, wherein said server including means for mapping a physical address to an address of an electronic mailbox upon receipt of an e-mail from a party, said server is connected to a network, said server further including an electronic mailbox for each physical address, wherein said electronic mailbox is associated with an account number and password; and
    - a recipient host that includes a web browser, said recipient host connected to said network, wherein said host can access said electronic mailbox on said server using said account number and said password.
2. The system of claim 1, wherein  
said server provides means for allowing said recipient to request that said e-mail be printed and forwarded via traditional mail.
3. The system of claim 1, wherein  
said server provides a graphical user interface that allows a recipient to select whether electronic mail is delivered to said electronic mailbox or is delivered via traditional mail.
4. The system of claim 1, further comprising  
a mailer host that includes a web browser, said mailer host connected to said network, wherein said mailer host includes a graphical user interface that allows said recipient to forward an e-mail to said recipient using said physical address.
5. A method for routing e-mail, comprising the following steps:  
allowing a user to specify a physical address of a recipient to whom the e-mail is to be sent; and

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

performing a mapping function on a server, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient.

6. The method of claim 5, further comprising the step of allowing said recipient to choose between receiving a physical mailpiece and an e-mail, wherein if said recipient chooses to receive e-mail, then storing the e-mail in an electronic mailbox for said recipient; and wherein if said recipient chooses to receive physical mail, then routing the e-mail to a printer where the e-mail is printed and delivered via traditional mail delivery means.
7. The method of claim 6, further comprising the steps of: associating said e-mail with one of a plurality of classes via an E-designator tag; and specifying said classes for which said recipient desires to receive a physical mailpiece and said classes for which said recipient desires to receive e-mail.
8. A method for routing e-mail, comprising the following steps: sending an e-mail using a physical address of a recipient, wherein said e-mail has a designator tag that associates said e-mail with one or a plurality of classes of service; performing a mapping function on a server upon receipt of said e-mail, said mapping function mapping said physical address of said recipient to an e-mail address of said recipient; specifying said classes for which said recipient desires to receive a physical mailpiece and said classes for which said recipient desires to receive an actual copy of the e-mail in a mail control file; storing the e-mail in an electronic mailbox of said recipient; and if said recipient chooses to receive physical mail, then routing the e-mail to a printer where the e-mail is printed, delivering the e-mail via traditional mail delivery

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

means, and electronically notifying said recipient and sender that a physical copy of the e-mail was sent to said recipient.

9. A system for routing e-mails, comprising:

a server that includes a database, said database including a mapping from a physical address to an e-mail address, wherein said server is connected to a network, said server further including an electronic mailbox for each physical address, wherein said electronic mailbox is associated with an account number and password, wherein said server includes a mail control file containing E-designators, said E-designators representing classes of service; and

a recipient host, said host being able to access e-mails on said server using said account number and said password.

10. A method for parcel delivery notification, comprising the following steps:

- (a) receiving an electronic order for a parcel;
- (b) generating a parcel barcode;
- (c) scanning a parcel barcode;
- (d) sending an e-mail to a buyer who placed said electronic order by e-mail, wherein a physical address of said buyer is used to send said e-mail, said step (d) occurring upon executing said scanning step (c);
- (e) shipping the parcel to a parcel delivery center;
- (f) scanning the parcel barcode at said parcel delivery center; and
- (g) electronically notifying said buyer who placed said electronic order by e-mail, wherein said physical address of said buyer is used to send said e-mail, said step (g) occurring upon executing said step (f).

11. The system of claim 1, further comprising

an interface that allows a party to send an e-mail using a physical address, said interface providing means for correcting said physical address.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

12. The system of claim 11, wherein said e-mail can be tagged as time sensitive by said party.
13. The method of claim 5, further comprising  
storing the e-mail in an electronic mailbox, wherein said electronic mailbox is associated with said recipient.
14. The method of claim 13, further comprising  
allowing said recipient to access said electronic mailbox using an account number and password.
15. The method of claim 13, further comprising  
requiring said recipient to enter biometric data to access said electronic mailbox.
16. The method of claim 5, further comprising  
printing the e-mail and mailing it to said recipient via traditional mail delivery means.
17. The method of claim 5, further comprising  
allowing said user to associate the e-mail with a class of service selected from a plurality of classes.

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

**Appendix IX – Evidence Appendix**

**None**

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34/35      March 15, 2007 Appellant's Appeal Brief

Serial No.: 09/801,725  
Attorney Docket No.: F-906-O1

Patent

**Appendix X – Related Proceedings Appendix**

None

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35/35 March 15, 2007 Appellant's Appeal Brief